

REMARKS

Claims 1 – 5, 7 – 21 and 23 – 25 remain in the application and stand rejected. Claims 6 and 22 are previously canceled. New claims 33 – 37 are supported by original independent claims 1, 14 and 17 – 19, and by the previously filed amendment after final. Claims 2, 15, 16, 20 and 24 – 25 are amended herein. No new matter is added.

New claims 33, 35 – 37 are supported by the original claims and by the previously filed amendment to claims 1 and 17 – 19 in the amendment after final filed September 12, 2003. New claim 34 is claim 14 substantially as originally filed. Claims 24 – 25 are amended to remove the recitations added by the previous amendment and so are claims 24 and 25 as amended by the amendment after final. No new matter has been added.

Claims 1, 14 and 17 – 19 are previously amended to include recitations of corresponding canceled but previously objected to dependent claims 26 and 28 – 31, and so, are canceled dependent claims 26 and 28 – 31 (which were previously indicated to encompass patentable subject matter) rewritten in independent form. Accordingly, claims 1, 14 and 17 – 19 encompass what, at least at some point in prosecution of this application, was agreed to be patentable over all references of record.

It has been asserted that claims 1 – 5, 7 – 21 and 23 – 25 (and also, that original claims 1, 14 and 17 – 19, which are re-presented as new claims 33 – 37) are unpatentable under 35 U.S.C. §102(a) over Netscape Navigator 3.0 to James. Essentially, it is asserted that James teaches the invention with Netscape 3.0 placeholder icons described in James serving as “a corresponding said generic object for each said associated at least one object.” Thus, it is asserted that:

James teaches a method of transferring data across a computer network which comprise setting data transfer constraints (Auto Load Images, Figure 8-15), requesting transfer of data (including image and sound data (page 357) stored on a remote computer system (inherent, page 360),

storing a plurality of generic objects (placeholders), each stored generic object corresponding to an original object in data requested (placeholder for each image), identifying at least one object (image) included in said requested data as being associated with a generic object (placeholder, Fig. 8-16) and substituting the generic object for each of said at least one object (page 361, line 3) responsive to said data transfer constraints (page 359, last paragraph), outputting said requested data including said generic objects (Fig. 8-16) or corresponding original objects (page 361, Fig. 8-16).

The rejection is respectfully traversed.

Section 2131 of the MPEP provides in pertinent part that

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH  
EVERY ELEMENT OF THE CLAIM

**"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."** *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP §2131.02.< **"The identical invention must be shown in as complete detail as is contained in the ... claim."** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

(emphasis added.) Thus, James must show describe in detail every feature of every claim rejected under 35 USC §102(a) as claimed. Furthermore, that description must enable a person skilled in the art to make and use the invention. See, MPEP §2131.02.

As previously noted, James is a usage guide to an old version of the well known Netscape Navigator. The portion of James upon which the final rejection is based is the chapter entitled "Graphics, Sound & Video" and in particular, how to "bypass graphics

altogether.” *See*, page 359, line 24. Figure 8 – 16 of James shows a single generic Netscape icon (i.e., a placeholder) that “(w)hen this option is turned off, a small icon appears as a placeholder wherever an image is supposed to display.” *Id*, lines 27 – 29. James fails to indicate how the icon is generated. Clearly, however, the James placeholder icon is resident in Netscape Navigator and not being supplied independently by the originating site. Thus, James teaches the same Netscape resident placeholder icons showing in a web page display that indicates where something is missing and conveying nothing more. If James taught replacing web page icons with a placeholder icon, for example, the applicants might be forced to agree with the Examiner. However, that is not what James teaches.

By contrast, for example, as claim 34 (original claim 14) recites, the present invention includes “storing a plurality of generic objects, each stored generic object corresponding to an original object in data requested from said remote computer system” at lines 5 – 6. This is not shown in James and certainly different than using a single small icon that “appears as a placeholder whenever an image is supposed to display.” James, page 359, lines 28 – 29. There is nothing in James to lead one to believe that the placeholder icon is anything other than an applet, e.g., defined in an object oriented language such as Java, that is called whenever an image that is to be displayed is not available. Even if the applicants were to agree that the James placeholder icon were a generic object, there is no reason why one would store “a plurality of generic objects, each stored generic object corresponding to an original object” as claim 34 recites. Further, claim 34 recites “substituting said each stored generic object for said corresponding object” at lines 7 – 8. Again, this is quite different than simply having a single small icon that “appears as a placeholder whenever an image is supposed to display.” *Supra*. Finally, nowhere does James teach “outputting said requested data, said output data selectively including said generic objects or corresponding original objects responsive to said data transfer constraints” at lines 9 – 11. Thus, a web page being passed for display includes objects that are displayed in the display. The object may be generic objects or the original corresponding objects, but they are transferred with the

data to the client system for display. Since the James placeholder icon appears “whenever an image is supposed to display” nothing is being transferred when the original images are not included. Similarly, each of independent claims 33 (lines 9 – 10), 35 (lines 7 – 9), 36 (lines 4 – 5), 37 (lines 11 – 12), 24 (lines 9 – 15) and 25 (lines 11 – 17) include such recitations. Therefore, James does not teach the present invention, especially as recited in claims 34, 15 and 16 or in independent claims 33 (lines 9 – 10), 35 (lines 7 – 9), 36 (lines 4 – 5), 37 (lines 11 – 12), 24 (lines 9 – 15) and 25 (lines 11 – 17). Therefore, since James does not teach the invention, James does not make the present invention unpatentable under 35 U.S.C. §102(a).

As further evidence that not only has James not anticipated the present invention, but also that the present invention is sorely needed even 5 years after filing the present application; the attached Appendix provides examples of current dial up Internet accelerator from Juno marked Exhibit A and/or NetZero marked Exhibit B, both provided by United Online, Inc. These services compress images from the originating site before sending the compressed image to reduce data flow to the web browser. While additional performance could be realized by substituting stick figure generic images, for example, for a quick and dirty initial download, selectively followed by the original images, this has yet to be realized in either of these services. That both services can charge a premium for dial up performance improvements is testament to the importance of improving dial up data transfer efficiency. Clearly, neither Juno nor NetZero nor the present invention as recited in any of claims 1 – 5, 7 – 21, 23 – 25 and 33 – 37 are suggested, much less disclosed under 35 U.S.C. §102(a) by simply having a single small icon that “appears as a placeholder whenever an image is supposed to display.” *Supra*. Reconsideration and withdrawal of the rejection of claims 1 – 5, 7 – 21 and 23 – 25 under 35 U.S.C. §102(a) is respectfully solicited.

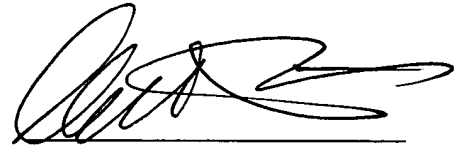
The applicants thank the Examiner for efforts in examining the application, both past and present. Believing the Application in condition for allowance for the reasons set forth above, the applicants request that the Examiner consider claims 33 – 37, reconsider

and withdraw the rejection of claims 1 – 5, 7 – 21 and 23 – 25 under 35 U.S.C. §102(a) and allow the Application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the Applicant's undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-0510 and advise us accordingly.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Charles W. Peterson, Jr.', written over a horizontal line.

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(Date)

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